

APPEAL BRIEF

Application No.: 09/509,377
Filing date: 08/28/2000
First named inventor: Sergey MATASOV
Art unit: 3739
Examiner: Leubecker, John P.
Mailing date: December 12, 2007

1. Real party in interest.

Applicant, inventor Sergey MATASOV

2. Related appeals and interferences.

(None)

3. Status of claims.

Claim 1	Currently amended, appealed.
Claims 2 - 11	Canceled.
Claim 12	Currently amended, appealed.
Claims 13-16	Canceled.
Claims 17-18	Currently amended, appealed.
Claims 19-22	Canceled.

4. Status of amendments.

The amended Claim 1, submitted on May 9, 2007. This amendment has not been acted upon by examiner.

The amended Claims 12, 17, 18, submitted on May 9, 2007 and August 1, 2007 have been acted upon by examiner and are denied entry.

The amended Claims 12, 17, 18, submitted in this brief, adopt examiner suggestions, as „correspond to those filed on August 10, 2005“. This amendment has not been acted upon by examiner.

The Claims 2-11, 13-16, 19-22 canceled on May 9, 2007. This amendment has not been acted upon by examiner.

The amended disclosure, page 1, line 17 submitted on May 9, 2007. This amendment has not been acted upon by examiner.

5. Summary of claimed subject matter.

The invention relates to the field of medicine, namely to colonoscopy and enteroscopy (*page 1, line 7*).

Concretely the present invention relates to endoscopes, wherein the transportation of an endoscopic tube is provided by an invaginator - a thin-walled tube eversible under fluid pressure (*page 1, lines 12-13*).

The objectives of the invention have been to increase reliability and convenience of introduction of an endoscopic tube, to perform biopsy in flexuous channels (*page 2, line 37-page 3, line 1*).

The increase of safety and convenience of introduction of the endoscopic tube (3) is ensured by the invaginator (23) formed in a compact hollow cylinder, which has a gap (25) with the endoscopic tube (3) (*page 3, lines 16-17, 21-22; Fig.1*).

Along with the invaginator, the convenience of the introduction is ensured by the mechanism (53) for introduction of the endoscopic tube (3), comprising a hermetic cavity (60), limited by a cylinder (56), a piston (57), an elastic tube (59) and is connected to fluid pressure (*page 3, lines 31-33; Fig.4c*).

For performing biopsy in flexuous channels the invention comprises a biopsy channel connected to fluid pressure and a biopsy forceps (63), which are a flexible hermetic tube with a piston (66) of the biopsy channel on the distal end of said tube and comprise an intensifier (71) of a traction line, which intensifier comprises an executing cylinder-piston unit, located on the distal end of the hermetic tube and of the traction line (*page 4, lines 23-30; Fig.4d*).

Implementation of said objectives will make colonoscopy available to general practice doctors, will make it easier for experienced endoscopists, gastroenterologists, abdominal surgeons (*page 3, lines 1-2*).

6. Grounds of rejection to be reviewed on appeal.

Objection concerning identification of reference on SU 1522466 in the specification.

Rejections of claims 11-13, 15, 17, 18 and 22 under 35 USC § 112 second paragraph, as being indefinite.

Rejections of claim 1 under 35 USC § 102(d) as being anticipated by SU 1522466.

Rejections of claims 13 and 15 under 35 USC § 103.

Indication concerning the allowance of claims 12, 17 and 18.

7. Argument.

Concerning the section "*Specification*".

As to item 2.

The objection is accepted – the „0000-00-00“ on page 1, line 17 of the disclosure from August 10, 2005 is replaced by “April 20, 1999” (see Enclosure 1), as SU 1522466 became

accessible to public (by MPEP, Section 2128) on April 20, 1999 under the publication of patent application of P-97-190 (LV), which serves as the priority application for the present application No. 09/509,377.

I did not ascertain any information about the identification form of references to an inventor's certificate having the priority and registration dates before the filing date of the priority application and being published after its filing date, but before the filing date of the present application in the Patent and Trademark Office. Therefore additionally are given the following formal data of the Inventor's Certificate SU 1522466 by Matasov:

- "Priority of the invention: August 21th, 1978" (see the title-page);
- "Registered in the USSR State register of inventions on July 15th, 1989" (see the title-page);
- "FOR OFFICE USE ONLY COPY № 03" (see the 1st page).

On the Online Public File Inspection EPOLINE (<http://www.epoline.org>) the publication of SU 1522466 took place on March 31, 2003, however in the column "publication date" the European PO specified "0000-00-00".

Concerning the section "Claim Rejections – 35 USC § 112".

As to item 4.

Claims 11-13, 15, 17, 18 and 22 were rejected by examiner under 35 U.S.C. 112, second paragraph, as being indefinite.

In the amended Claims the claims 11, 13, 15 and 22 are canceled, but references in the claims 12, 17 and 18 are properly corrected.

Objections concerning the section "Claim Rejections – 35 USC § 102".

As to item 6.

The examiner rejected the claim 1 under 35 U.S.C. 102(d) as being anticipated by SU 1522466. At that was alleged that SU 1522466 discloses the "cartridge (4) ... formed of a compact cylinder (7)" and that "Inherently there is a gap between the cylinder and the endoscopic tube".

In accordance with 37 CFR § 1.192 (c)(8) (iii) an applicant should specify the errors in the rejection and why the rejected claim is patentable under 35 U.S.C. 102.

The error in the rejection are examiner's allegations that SU 1522466 discloses the "cartridge (4) ... formed of a compact cylinder (7)" and that "Inherently there is a gap between the cylinder and the endoscopic tube", as there is no arguments in favour of this assertion. Thereupon examiner did not cited any.

So in order to prove the patentability of claim 1, there should be refuted the assertions of examiner that SU 1522466 discloses the "cartridge (4) ... formed of a compact cylinder (7)" and "Inherently there is a gap between the cylinder and the endoscopic tube".

SU 1522466 comprises 5 obvious evidences of friable (non-compact) structure of invaginator and of absence of a gap between it and the light pipe 3. So, invaginator by SU 1522466:

1. *"is executed as pleated"* (see the Claims; column 3, line 3 and others; drawing), that is it has small parallel pleats, which facilitate its gathering on the light pipe 3;
2. is *"gathered on the light pipe 3"* (see column 4, lines 19-20);
3. is *"adjacent to the light pipe"* (see the Claims; column 3, line 2);
4. could be longitudinally compressed (see column 3, lines 48-51);
5. cuddles to the light pipe 3 under the action of working pressure (see col. 4, lines 47-49);

Besides, in the text of SU 1522466 there are absent:

- word-combination "formed of a compact cylinder",
- word-combination "compact cylinder",
- word "cylinder",
- word "gap".

The detailed description of friability (non-compactness) of the pleated invaginator and absence of its gap with an endoscopic tube, is both in the SU 1522466 and in the present application:

- *"When the difficulties appears with the insertion of the light pipe 3 ... there is necessary to reduce on few seconds the pressure to zero and then repeatedly raise it till the working level and to continue insertion of the light pipe. In the moment of absence of pressure the pleated part of tube does not cuddle to the light pipe and under the action of spring 10 is able to displace to the projection 6 on the place of tube, which has turned into everted part."* (see SU 1522466, column 4, lines 40-49);
- "The invaginator is to be everted under tip 6, but during invagination the distal part of tube 3 becomes bared. It can be due both to lack of a gap between tube 3 and uneverted part of the invaginator and to a friable structure of the latter, which under the action of air pressure adheres to tube 3." (see the original specification from October 2, 1998, page 1, lines 37-41);

By its compactness the pleated invaginator according to SU 1522466 and the invaginator according to the present application could be compared approximately as a haycock and a wafer of hay. Here are 5 positive differences of invaginator according to the present application, formed in a compact hollow cylinder which has a gap with an endoscopic tube. So, invaginator according to the present application:

1. "is formed of crumpled and tightly compressed in longitudinal and transverse directions short layers of different forms of an eversible thin-walled tube" (see the original specification from October 2, 1998, page 3, lines 24-25);
2. is not gathered on the endoscopic tube, but is putted on it as a whole,

3. does not cuddle to the endoscopic tube, because the diameter of the inner forming (moulding) rod is larger than the diameter of the endoscopic tube,
4. could not be longitudinally compressed because is formed in the longitudinal direction,
5. does not cuddle to the endoscopic tube under the action of working pressure, because is formed in the transverse direction.

One can see evidently, that invaginator according to the present application, formed in a compact hollow cylinder which has the gap with the endoscopic tube, is not the subject-matter of SU 1522466. Therefore, the rejection of claim under 35 U.S.C. 102(d) as anticipated by SU 1522466, is an error.

Please, also note that from 9 patent offices, which made the examination of the application PCT/LV98/00006, solely the USPTO asserted, that the invaginator, formed in a compact hollow cylinder which has a gap with the endoscopic tube, is disclosed in the inventors certificate SU 1522466.

About the real reason of rejection of claim 1.

On November 11, 2007 I have received the letter from California (it is attached but, probably, could be published upon author's consent) with the following question:

"Sightline product seems very similar to yours. How does it work without affecting your earlier i.p.?"

Here is the answer on this question. So, examiner Leubecker:

- performed the International Search for the application PCT/IL00/00017 by Sightline Technologies Ltd.,
- on the national stage in 6 months (!) performed the examination of the application by Sightline Technologies Ltd.,
- on November 26, 2002 granted the patent № 6,485,409 according the application by Sightline Technologies Ltd., wherein the independent claims 1 and 4, both separately and in combination, are anticipated by the inventor's certificate SU 1522466 and claim 1 of my application.

Thus, the real reason of rejection of my invention lies in fact, that it affects the illegal rights of Sightline. In order to confirm these rights, examiner Leubecker has ignored:

- during the International Search – the publication of my priority application from February 20, 1999 and the publication WO 99/17655 from April 15, 2000,
- during the national phase – my application 09/509,377, though at the same time he performed the examination both of Sightline and of my applications,
- my petitions from January 21, 2003 and September 1, 2004 concerning the infringement of 35 USC § 102 by the patent of Sightline,
- the inventor's certificate SU 1522466 (disclosed in all publications of my application and patents), which anticipate he claim 1 of Sightline's patent

The claim 1 is amended, the claims 4, 5, 10, 11, 21, 22 are canceled.

Concerning the section "**Claim Rejections – 35 USC § 103**".

As to items 8, 9.

Claims 13 and 15 are canceled.

Concerning the section "**Allowable Subject Matter**".

As to item 10.

The references in claims 12, 17 and 18 are amended in accordance with objections of examiner. These claims completely correspond to those, filed on August 10, 2005.

Faithfully Yours,
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8. Claims appendix

1. An endoscope comprising an invaginator in the form of a tube eversible under fluid pressure, which is arranged by pleats on the distal part of an endoscopic tube (3), characterized in that the invaginator (23) is formed in a compact hollow cylinder, which has a gap (25) with the endoscopic tube (3).

12. The endoscope according to claim 1, further comprising a mechanism (53) for introduction of the endoscopic tube (3) into the everted part of the invaginator, which mechanism comprises a hermetic cavity (60), limited by a cylinder (56), a piston (57), an elastic tube (59) and is connected to fluid pressure.

17. The endoscope according to claim 1, wherein the endoscopic tube (3) comprises a biopsy channel, connected to fluid pressure and biopsy forceps (63), which are a flexible hermetic tube with a piston (66) of the biopsy channel on the distal end of said tube.

18. The endoscope according to claim 17, wherein the biopsy forceps (63) comprise an intensifier (71) of a traction line, which intensifier comprises an executive cylinder-piston unit, located on the distal end of the hermetic tube and of the traction line.

Faithfully Yours,
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9. Evidence appendix.

Device

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Sunday, November 11, 2007 1:50:42 AM
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EP1036539...pdf (774.1 KB), 06485409_...tif (527.3 KB)

Dear Sergey,

Hello, my name is Alex Tilson. I live in California and am doing a project on devices that facilitate improved colonoscopy.

I ran across your patent and then found your website. I also saw your article with your vision of what colonoscopy can be in the future: it should be painless, it could be done by family practitioner, I couldn't agree more.

Of all of the potential next-gen devices, the only one that I know of that has made it to market in America is Sightline. well, at least they are due to come to market before the end of the year.

There is also Spirus, but their product doesn't really work. Sightline product seems very similar to yours. how does it work without affecting your earlier i.p.?

I see that you are a physician. do you use your product in the clinic and, if so, how well does it work?

Congratulations of your fine work.

Sincerely,

Alex Tilson

home phone 28650 29 347-1576

P.S. Though I have never been to Latvia, I did bicycle across much of the former Soviet Union.

See our website www.rutmans.org/Trek

10. Related proceedings appendix.

(None)